

P15742.A09

addition of language such as "said bending means terminating at a position less than half the height of the helmet" to claims 1 and 18 would appear to be allowable over the prior art of record, subject to a search update, is also appreciated.

Applicants also note with appreciation the Examiner's indication that claims 14 and 15 are allowed, and that claims 17 and 20 include allowable subject matter.

Upon entry of the above amendment, claims 1, 2, 5 and 6 have been amended and new claims 21 and 22 have been presented to overcome the Examiner's rejection under 35 U.S.C. § 112, second paragraph, and the rejections based on prior art under 35 U.S.C. § 102(b) and § 103. Accordingly, claims 1-22 are currently pending and Applicants respectfully request reconsideration of the outstanding rejections and allowance of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

The Examiner has rejected claims 5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. As noted above, claim 5 has been amended and is believed to overcome the Examiner's rejection noted above.

Accordingly, in view of the above-noted amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under 35 U.S.C. § 112, second paragraph.

P15742.A09

The Examiner has also rejected claims 1 - 3, 6 - 8, 16, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by U. S. Patent 3,197,784 (CARLISLE). The Examiner considers the protective helmet taught by CARLISLE to include a main outer shell of deformable material having resilient bending means formed by downwardly opening cutouts between segments 20-41, and that claims 1 - 3, 6 - 8, 16, 18 and 19 read on this structure.

However, Applicants point out that the device of CARLISLE is a bonnet, and not a protective helmet of the type of their invention. The bonnet of CARLISLE does not have a main outer shell formed by a wall (the segments of CARLISLE clearly do not constitute a wall) or a facial opening as recited in claims 1 and 18, and particularly does not have the configuration of the wall as now recited in claim 1 as amended. Additionally, CARLISLE does not disclose a rear lower portion that corresponds to the zone occupied by the nape of the user as disclosed by Applicants in lines 9 and 10 on page 4 of the specification as originally filed and clearly recited in claims 1 and 18.

In this regard, contrary to the Examiner's comments, the device of CARLISLE does not include "a rear lower portion, which corresponds to the zone occupied by the nape of the user" as required by claims 1 and 18 because the device of CARLISLE does not extend even to a position adjacent the nape of the user as seen in Fig. 1 thereof. Webster's New World Dictionary, Third College Edition, 1991, defines "nape" as "the

P15742.A09

back of the neck". It is clear that the device of CARLISLE merely overlies portions of the head and does not even extend down to the region of the neck.

Thus, since CARLISLE fails to disclose each and every element recited in independent claims 1 and 18, claims 1 and 18 are clearly not anticipated thereby under 35 U.S.C. § 102(b). It follows that claims 2, 3, 6 - 8, 16 and 19, which depend from claims 1 and 18, also cannot be anticipated by CARLISLE under § 102(b). Furthermore, Applicants' maintain that the claimed helmet structure including the bending means (or bending portion) comprising at least one cutout in the rear lower portion to define at least two deformable portions, with at least one cutout extending to a position less than half the height of the helmet and a nape cushion removably attached to the helmet in the area of the cutout as recited in claims 16 and 19, are both features which are neither taught nor suggested by CARLISLE or any of the prior art of record. Thus, the Examiner is requested to withdraw the rejection of claims 1 - 3, 6 - 8, 16, 18 and 19 under 35 U.S.C. § 102(b) for all the above reasons.

The Examiner has also rejected claims 1 - 3, 6 - 8 and 18 under 35 U.S.C. § 102(b) as being anticipated by U. S. Patent 4,477,929 (MATTSON). The Examiner considers the protective helmet taught by MATTSON to include a main outer shell of deformable material having resilient bending means formed by two lateral cutouts which divide the helmet into a front helmet portion 1 and a back flap 2, which extends to the zone occupied

P15742.A09

by the nape of the user, and is at least deformable in the area of hinge 14, and that claims 1 - 3, 6 - 8 and 18 read on this structure.

However, Applicants point out that the device of MATTSON does not include a deformable rear portion, and in particular, does not include resilient bending means in the lower rear portion that corresponds to the zone occupied by the nape of the user as required by claims 1 and 18. The helmet of MATTSON includes a hinge 14, which is not disclosed as being "resilient", even though it is likely formed of the "impact receiving plastics layer 4" that forms the shell. In this regard, it is just as likely that the hinge 14 is flexible, without being resilient, because there is no need for the hinge 14 to be resilient since the flap 2 is held in a fixed position during use. It is well settled that an anticipation rejection cannot be predicated on an ambiguous reference. See In re Turley, 304 F.2d 893, 134 USPQ 355 (CCPA 1962)

Moreover, even if the hinge 14 of MATTSON could be considered to be resilient, the lower portion of the rear flap 2 that is connected by the hinge to the front part 1, and which may extend to a position near the nape of the user, is fixed in position relative to the front part 1 by the tongue 8 and screw 7, and thus does not "bend". Accordingly, the portion of the helmet of MATTSON that may be positioned within the zone of the nape of the user does not, and cannot, have a "resilient bending means/portion" as required by claims 1 and 18. Thus, since MATTSON fails to disclose each and every element recited

P15742.A09

in independent claims 1 and 18, claims 1 and 18 are clearly not anticipated thereby under 35 U.S.C. § 102(b). It follows that claims 2, 3 and 6 - 8, which depend from claim 1, also cannot be anticipated by MATTSON under § 102(b). Thus, the Examiner is requested to withdraw the rejection of claims 1 - 3, 6 - 8 and 18 under 35 U.S.C. § 102(b) based on MATTSON for all the above reasons.

The Examiner has also rejected claims 4 and 5 under 35 U.S.C. § 103 as being unpatentable over CARLISLE or MATTSON in view of U.S. Patent No. 5,165,166 (SIMPSON). The Examiner has taken the position that CARLISLE and MATTSON teach the helmet structure as claimed except for the particular composite material of claims 4 and 5, and concludes that one of ordinary skill in the art would have found it obvious to form the helmet of CARLISLE or MATTSON from the composite taught by SIMPSON. However, the patent to SIMPSON does nothing to provide the deficiencies of the bonnet of CARLISLE or of the helmet of MATTSON noted above, and the Examiner's rejection of claims 4 and 5 must fall for this reason alone.

The Examiner has also rejected claims 9-13 under 35 U.S.C. § 103(a) as being unpatentable over CARLISLE. The Examiner takes the position that CARLISLE discloses the invention substantially as claimed, except for the shapes and lengths of the cutout, and concludes such would have been obvious to one having ordinary skill in the art.

However, none of the applied prior art, including CARLISLE, teaches or suggests Applicants' claimed protective helmet having the particular cutouts recited in claims 9-13. While the Examiner has indicated that such features are "obvious", Applicants note that in establishing a prima facie case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972 (BPAI 1985) To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Notwithstanding the Examiner's statement in the rejection that the purpose of providing the different shapes would be to "alter the protection provided in certain areas," Applicants contend that this motivation results only from a review of Applicants' disclosure, and not from anything found in CARLISLE or any of the applied prior art.

It is impermissible to use Applicants' claimed invention as an instruction manual or "template" to piece together isolated disclosures and teachings of the prior art so that the claimed invention is purportedly rendered obvious. See In re Fritch, 972 R.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Rejections based on § 103 must rest on a

P15742.A09

factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art, and the Examiner has the initial duty of supplying the factual basis for the rejection and may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967).

As stated in W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is apparent that the only reason to modify the teachings of the CARLISLE in the manner proposed by the Examiner results from a review of Applicants' disclosure and the application impermissible hindsight. Accordingly, the rejection of claims 9 - 13 under 35 U.S.C. § 103(a) based on CARLISLE is improper for all the above reasons, and the Examiner is respectfully requested to withdraw the same.

Additionally, Applicants' submit that new claims 21 and 22, which recite that the bending means (or portions) of the protective helmet terminates at a position less than half the height of the helmet, which feature is clearly not taught by any of the applied

P15742.A09

references, is also patentable over all of the prior art of record. Thus, the Examiner is respectfully requested to indicate an early allowance thereof.

Thus, Applicants respectfully submit that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. § 102 and § 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

#### CONCLUSION

In view of the foregoing, it is submitted that the present amendment is proper and that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicants' invention, as recited in each of claims 1 - 22. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, consideration of the present amendment, reconsideration of the outstanding Office Action, and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.



P15742.A09

Any comments or questions concerning this application can be directed to the undersigned at the telephone number given below.

Respectfully submitted,  
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